



26 JAN 2009

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In re Application of:	:	
Robert Victor JONES	:	DECISION ON PETITION
Application No.: 10/598,111	:	UNDER 37 CFR 1.137(b) and
PCT Application No.: PCT/AU2005/00221	:	REQUEST UNDER 37 CFR
Int. Filing Date: 15 February 2005	:	1.497(d)
Priority Date: 19 February 2004	:	
Attorney's Docket No.: -None-	:	
For: CAMERA SYSTEM	:	

This is in response to the "Renewed Petition Under 37 C.F.R. §1.137(b)," filed 30 September 2008.

### **BACKGROUND**

On 10 December 2007, a Decision dismissing applicant's petition under 37 CFR 1.137(b) was mailed. The Decision indicated that petitioner failed to provide the required reply required under 37 CFR 1.137(b). Specifically, petitioner failed to provide a properly executed declaration in compliance with 37 CFR 1.497(d), as the inventorship identified on the declaration does not correspond with the inventorship identified in the international phase of the international application.

On 06 February 2008, applicant filed a renewed petition under 37 CFR 1.137(b) accompanied by a "Statutory Declaration".

On 31 March 2008, a Decision was mailed dismissing the renewed petition on the basis that the requirements under 37 CFR 1.497(d) to correct inventorship have not been complied with and, consequently, the renewed petition failed to include the required reply necessary to revive the instant application.

On 30 September 2008, applicant filed the present renewed petition considered herein accompanied by a Statement by Added Inventor and an executed declaration under 37 CFR 1.63.

### **DISCUSSION**

Pursuant to 37 CFR 1.137(b), a petition to revive the present application based upon unintentional abandonment must include: (1) the proper reply, unless previously filed; (2) the petition fee under 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required

reply from the due date for the reply until the filing of a grantable petition was unintentional; and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Items (2)-(4) were previously satisfied. See Decision mailed 10 December 2007.

With respect to item (1), petitioner has not provided the required reply. As indicated in the prior decision, correction of inventorship is by way of compliance with the provisions of 37 CFR 1.497(d), which states:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

With respect to (1), the renewed petition includes the required statement by the added inventor, Gianni Caldarera. With respect to (2), the processing fee has previously been paid. With respect to (3), petitioner states that there is no assignee from whom consent pursuant to 37 CFR 1.497(d)(3) would be required. With respect to (4), a new oath or declaration is not required under paragraph (f).

However, the declaration filed with the renewed petition, as well as the declaration filed 26 November 2007, contain non-initialed/non-dated alterations, and accordingly, can not be accepted. See MPEP 605.04(a):

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will require a new oath or declaration if the alterations are not initialed and dated.

It also appears that the citizenship and first name of the second inventor indicated on the later submitted declaration are in error.

**CONCLUSION**

For the above reasons, the petition under 37 CFR 1.137(b), and the request to correct inventorship under 37 CFR 1.497(d) are **DISMISSED**, without prejudice.

If reconsideration of the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." No additional fee is required. Extensions of time under 37 CFR 1.136(a) are permitted.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Boris Milef/

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